

### **Remarks**

After entry of the present Amendment, claims 1-27, 29, and 30 are pending in the present application with claims 3, 9, 13-21, 23-27, and 29 withdrawn from consideration. Claims 1, 2, 5-7, 11, 13, 14, 19, 21, 22, and 25 are currently amended to correct grammar, to correct antecedent basis issues, and to overcome rejections under §112, second paragraph. Dependent claim 28 is currently cancelled to overcome a rejection under §112, second paragraph. New independent claim 30 is currently added as a new claim. Support for new independent claim 30 is found throughout the specification and drawings and no new matter is being introduced.

Claims 4-8, 11-12, 22, and 28 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1, 4, and 8 stand rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103 as obvious over FR 2 637 548. Claims 1, 4, 8, 22, and 28 stand rejected as anticipated by or, in the alternative, under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103 as obvious over EP 0 458 705. Claims 1, 4, and 8 stand rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103 as obvious over FR 2 735 426. Claims 1, 4, and 8 stand rejected under 35 U.S.C. §103 as obvious over DE 100 42 683 in view of DE 196 26 441 or EP 0 357 801. Claim 2 stands rejected under 35 U.S.C. §103 as obvious over any one of the rejections as applied to claim 1 and further in view of DE 19 626 441; FR 2 637 548; or EP 0 357 801. Claim 5 stands rejected under 35 U.S.C. §103 as obvious over any one of the rejections as applied to claim 1 and further in view of any one of EP 0 607 585 or EP 0 458 705. Claim 6 stands rejected under 35 U.S.C. §103 as obvious over any one of the rejections as applied to claim 1 and further in view of FR 2 735 428 and in further view of EP 0 357 801. Claim 7 stands rejected under 35 U.S.C. §103 as obvious over any one of the rejections as applied to claim 1 and further in view of DE 197 39 578. Claims 10-12 stand rejected under 35 U.S.C. §103 as obvious over any one of the rejections as applied to claim 1 and further in

view of DE 100 57 039; DE 100 45 438; or JP 06-183248. Claims 22 and 28 stand rejected under 35 U.S.C. §103 as obvious over any one of the rejections as applied to claim 1 and further in view of EP 0 458 705.

### **Rejections under §112, Second Paragraph**

The Examiner rejects claim 4 under §112, second paragraph because, as the Examiner states, “it is unclear which direction the ‘longitudinal axis’ extends because no particular direction is specified.” Claim 4 merely claims that “the heating module (12) extends along a longitudinal axis and the ventilation module (14) is placed next to the heating module (12) along the longitudinal axis.” The Applicants are unsure as to why a direction must be claimed, as stated by the Examiner, and respectfully request clarification of this rejection. Simply stated, the Applicants are merely claiming that the heating module 12 extends along a longitudinal axis and the ventilation module 14 is along the longitudinal axis.

The Examiner rejects claim 5 based on the “unconventional” use of the term “turbine.” Accordingly, the term “turbine” is replaced with the term “blower.” The Applicants respectfully assert that the specification and Figures 1, 3, and 8 support this amendment because one of ordinary skill in the art would recognize the “turbine 22” as a “blower.” The Applicants respectfully assert that this amendment overcomes the rejection under §112, second paragraph.

The Examiner rejects claim 6 based on the language “bottom to top” because the Examiner states that phrase implies orientation relative to the vehicle. In order to clarify, claim 6 is currently amended to read, “from ~~bottom~~ the lower portion to a top portion of said heating module (12).” As amended, the Applicants respectfully assert that any orientation is based relative to the heating module 12. Accordingly, the Applicants respectfully assert that the rejection of claim 6 based on §112, second paragraph is overcome.

The Examiner rejects claim 7 based on the term “above” because the Examiner states

that “above” implies orientation relative to the vehicle. Claim 7 is currently amended to replace the term above and clarify orientation relative to the heating module 12. Accordingly, the Applicants respectfully assert that the rejection of claim 7 based on §112, second paragraph is overcome.

The Examiner rejects claim 8 because the Examiner states that “inclined” and “horizontal” imply orientation relative to a vehicle. The Applicants respectfully assert that claim 8 is merely claiming orientation of a component “with respect to horizontal” and does not mention the orientation with respect to a vehicle. Since claim 8 makes absolutely no mention of a vehicle, the Applicants are unsure as to why the Examiner concludes otherwise. Accordingly, the Applicants respectfully assert that claim 8 is not indefinite and respectfully request further clarification.

The Examiner rejects claims 11-12 based on “right and left side.” Claim 11 is currently amended to delete “right and left side.” Accordingly, the Applicants respectfully assert that the rejection of claims 11-12 is overcome.

### **Rejections under §102**

#### Claims of Behr Opposition were Submitted in July 17, 2009 IDS

First, with respect to the Opposition of EP 1 601 543 by Behr before the European Patent Office (hereinafter Behr Opposition), the Examiner asks on page 4 of the Final Office Action, “did it not occur to the applicant that having the claims that correspond to the Opposition would be a necessary prerequisite to meaningfully understand it?” In fact, this did occur to the undersigned and the undersigned notes that a translation of the granted claims of EP 1 601 543 was submitted in an IDS on July 17, 2009. This document was entitled “English translation of claims as granted for European patent EP 1 601 543” on the Form PTO/SB/08a submitted with the IDS on July 17, 2009. Specifically, in the IDS submission of July 17, 2009,

the translated claims are appended to a copy of EP 1 601 543, which together form a 26 page NPL document, which appears to be uploaded onto PAIR but not available for electronic viewing.

The Behr Opposition does, in fact, involve the granted claims of EP 1 601 543. In other words, the claims that are translated in the IDS submitted on July 17, 2009 are the same claims that are being opposed in the Behr Opposition. The undersigned also sent a copy of these translated claims to the Examiner via email on March 11, 2010 and, to be clear, the claims sent to the Examiner via email on March 11, 2010 are a translation of the claims being opposed in the Behr Opposition. As set forth above, if the Examiner has such questions in the future, the undersigned invites the Examiner to telephone the undersigned so that the undersigned can provide clarification in an attempt to expedite the prosecution of the present application.

Claim 1 of Present Application is Different than Claim 1 of EP 1 601 543

Even after reviewing the opposed claims of EP 1 601 543, the Examiner states in the Examiner's Interview Summary dated March 15, 2010 that "[t]he claims in EP 1601543 B1 and those in the present application are extremely similar, notwithstanding applicant's [sic] comments to the contrary (see November 5, 2009 response, page 8, bottom)." To avoid any confusion, claim 1 of the present application (hereinafter U.S. claim 1) and claim 1 of EP 1 601 543 (European claim 1) are each presented below:

U.S. Claim 1:

1. (Currently Amended) A device for heating-ventilation and/or air-conditioning ~~[[the]]~~ a passenger compartment of a motor vehicle, including means for producing an air flow at an adjusted temperature, as well as air outlets for defrosting, aeration and foot-warming which are supplied by this adjusted air flow and are suitable for being connected to ducts leading into the passenger compartment,

characterised in that it comprises at least one ventilation module (14), at least one heating module (12), and at least one distribution module (16) grouped substantially at the same horizontal level;

said at least one ventilation module (14) arranged to produce the air flow;

said at least one heating module (12) comprising a housing (30) connected to said ventilation module, an air inlet (28) in said housing (30) for the air flow, heat exchangers (32, 34, 36) disposed in said housing (30) through which the air flow can pass, and at least one side air outlet (46d, 46g) in said housing; and

said at least one distribution module (16) having a casing (52) with air outlets (54, 56, 58) and with an inlet (50) connected to ~~[[a]]~~ at least one of said side air ~~outlets~~ outlet (46d, 46g) of the heating module, ~~[[and]]~~ said distribution module comprising distribution means disposed within said casing (52) for distributing the air flow between the air outlets (54, 56, 58), said distribution means configured to selectively open and close the air outlets (54, 56, 58) for leading the ~~airflow~~ air flow to selected areas of the passenger compartment.

European Claim 1:

1. Heating-ventilation and/or air-conditioning device for the passenger compartment of a motor vehicle, which comprises means for producing a flow of blown air at an adjusted temperature, and also de-icing, ventilation and foot heater outlets that are supplied with this stream of temperature-adjusted air, is suitable for being connected to vents opening into the passenger compartment and is composed of modules grouped together substantially at the same horizontal level and comprising:

at least one ventilation module (14) designed to produce a stream of blown air;

and characterized by

at least one thermal module (12) designed to be fitted into a central region of the passenger compartment and comprising an air inlet (28) for the blown air, heat exchangers (32, 34, 36) suitable for the flow of air to pass through them, and at least one lateral air outlet (46d, 46g); and

at least one distribution module (16) having an inlet (50) connected to a

lateral air outlet (46d, 46g) of the thermal module and including distribution means for distributing the flow of air between air outlets (54, 56, 58) opening into chosen regions of the passenger compartment.

Clearly, U.S. claim 1 is not “extremely similar” to European claim 1. As just a few examples of elements not claimed in the European claim 1, the U.S. claim 1 claims “a housing (30) connected to said ventilation module,” “a casing (52) with air outlets (54, 56, 58),” and “distribution means disposed within said casing (52).” It appears as though the Examiner is relying heavily on the Behr Opposition; however, the Examiner must appreciate the differences between U.S. claim 1 and European claim 1 and an independent evaluation of U.S. claim 1 is warranted.

Since the U.S. claim 1 is different than the European claim 1, the Applicants are unsure as to how the Examiner is applying the various references discussed in the Behr Opposition. Specifically, since the Final Office Action merely refers to the Behr Opposition, which is only applicable to European claim 1, the Applicants are unsure as to how the Examiner is applying the references to the U.S. claim 1. Accordingly, the Applicants request that the next Office Action repeat the pending claims and identify, with reference numerals, how any prior art reference applies to the pending claims. With reference to 37 C.F.R. §1.104(c)(2), “[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.”

#### Response to Behr Opposition Submitted Herewith

The Applicants’ Response to the Behr Opposition, which the Applicants submitted to the European Patent Office, will be submitted in an Information Disclosure Statement. The Applicants note that the claims of EP 1 601 543 remain un-amended and, in fact, the

Applicants rebut each and every assertion of lack of novelty or inventive step made in the Behr Opposition. Since the Examiner appears to rely heavily on the Behr Opposition, the Applicants invite the Examiner to review the Applicants' Response.

### **Rejections under §103**

The Examiner rejects independent claim 1 with four different modifications and combinations of references on pages 5 and 6 of the Final Office Action. Again it appears as though the Examiner relies entirely on the Behr Opposition to support this rejection. The Applicants note that the Behr Opposition discusses inventive step under a European standard, which is a different legal standard than the obviousness standard in U.S. practice.

With reference to MPEP §2141, “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” (emphasis added). Citing the opinion by the Supreme Court of the United States for *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), the Board of Patent Appeals and Interferences stated in a precedential opinion that “this analysis should be made explicit.” *Ex parte Thomas J. Whalen*, Appeal 2007-4423 (emphasis added). The present rejection of independent claim 1 under §103(a) merely discusses inventive step analysis from a European Opposition and provides no articulation of the reasons why the claimed invention would have been obvious. As such, the Applicants respectfully assert that the Examiner has not established a *prima facie* case of obviousness.

### **New Claim**

New independent claim 30 is currently added to claim an additional scope of the invention. It is noted that new independent claim 30 is clearly different than European claim 1 discussed above. As set forth above, independent claim 1 is currently rejected under §102 over FR 2 637 548; EP 0 458 705; and FR 2 735 426. The Applicants respectfully assert that each

of these references fail to teach a modular configuration including a ventilation module, a heating module, and a distribution module, as claimed in new independent claim 30. In other words, these references fail to teach a device for heating-ventilation and/or air conditioning having three different *modules* interfaced with one another, i.e., three separate components each dedicated to a specific function. For at least this reason, the Applicants respectfully assert that new independent claim 30 is novel over FR 2 637 548; EP 0 458 705; and FR 2 735 426.

In view of the foregoing, it is respectfully submitted that independent claims 1 and 30, and the claims that depend therefrom, are both novel and non-obvious such that these claims are in condition for allowance, which allowance is respectfully requested. If any issue regarding the allowability of any of the pending claims could be readily resolved, or if other action could be taken to further advance prosecution, such as an Examiner's Amendment, it is respectfully requested that the Examiner telephone the undersigned in this regard.

A Request for Continued Examination and associated fee are submitted herewith. Although no additional fees are believed to be due, the Commissioner is authorized to charge our Deposit Account No. 08-2789 in the name of Howard & Howard Attorneys PLLC for any fees or credit the account for any overpayment for this matter.

Respectfully submitted,

**HOWARD & HOWARD ATTORNEYS PLLC**

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